

REMARKS

Summary of the Office Action

This Amendment responds to the Office Action mailed on December 24, 2008.

Claims 1 and 3-21 are pending in this application. Accordingly, claims 1 and 3-20 as amended and new claim 21 are respectfully submitted for reconsideration by the Examiner. No new matter has been added as the amendments are believed to be fully supported by the specification, claims and drawings as originally filed.

Rejections to the Claims Under 35 U.S.C. § 102(b)

Claims 1 and 3-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP-A-2002-337066. Claims 1 and 3-16 were rejected under 35 U.S.C. § 102(b) for the same reasons as set forth in paragraph 3 of the Office Action dated October 29, 2007.

Claim 1

Claim 1 as amended recites, in part, a contact nose that comprises a “cylindrical portion” that defines a circular cylindrical bore *having a longitudinal axis and a substantially uniform cross section transverse to the longitudinal axis*, the circular cylindrical bore extending from an interior of the contact nose to *an upper end surface substantially transverse to the longitudinal axis of the upper end*.

Referring to marked up FIG. 6 on page 3 of the Office Action, portions 45, 37 and 36 do not define a “cylindrical portion” that defines a circular cylindrical bore having a longitudinal axis and a substantially uniform cross section transverse to the longitudinal axis, the circular cylindrical bore extending from an interior of the contact nose to an upper end surface substantially transverse to the longitudinal axis of the upper end.

Accordingly, JP-A-2002-337066 (nor marked up FIG. 6) disclose a “contact nose” as recited by claim 1, and thus the rejection of claim 1 under 35 U.S.C. § 102(b) should be withdrawn.

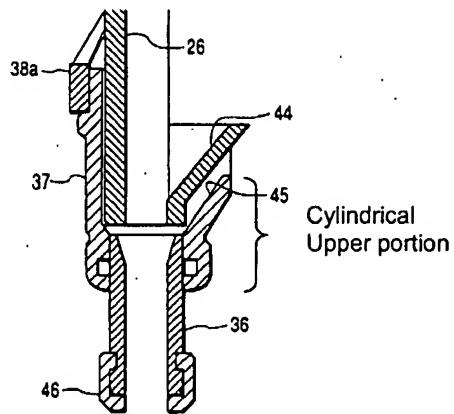
Claims 3-7

Claims 3-7 depend or ultimately depend from claim 1, and thus are believed patentable over JP-A-2002-337066 for the same reasons as claim 1 as well as the additional features they recite.

Claim 8

Claim 8 was rejected for the reasons set forth in paragraph 3 of the Office Action dated October 29, 2007, noting that the “guide portion especially shown in FIG. 6 can accommodate nails that have a length less than or equal to the distance measured from the leading end of the contact nose to a farthest extent of the radial enclosure.” Office Action dated October 29, 2007 at ¶3. See also, *Id.* at Response to Arguments, ¶6 (“Upper portion 37 is a cylindrical portion...with an escape opening. Therefore, the nose body is circumferentially received within the contact nose.”). Marked up FIG. 6 of the Office Action dated October 29, 2007 is reproduced below.

FIG. 6



Claim 8 recites, in part, a power-driven nailing machine comprising...“a contact nose having a leading end, the contact nose including a hollow member with proximal and distal ends, the hollow member defining inner and outer surfaces extending from the proximal end

to the distal end, the fourth end of the nose body being circumferentially received within the proximal end of the hollow member.”

The rejection states that the alleged “nose body is circumferentially received within the contact nose.” Office Action dated October 29, 2007 at ¶6, Response to Arguments (above). However, the alleged nose body is not circumferentially received within the proximal end of the alleged hollow member. Accordingly, the rejection fails to disclose the “contact nose” as recited by claim 8, and the rejection of claim 8 as anticipated should be withdrawn.

Claims 9-20

Claims 9-20 depend or ultimately depend from claim 8, and thus are believed patentable over JP-A-2002-337066 for the same reasons as claim 1 as well as the additional features they recite.

For instance, claim 17 recites that “the proximal end of the hollow member comprises a first circular cylindrical bore defined by the inner surface and the fourth end of the nose body is circumferentially received within the first circular cylindrical bore.” The alleged nose body that is identified in the rejection of claim 8, however, is not circumferentially received within the proximal end of the alleged hollow member. (Above) Moreover, the alleged fourth end of the alleged nose body is not “circumferentially received within [a] circular cylindrical bore,” as recited by claim 17. Thus, JP-A-2002-337066 fails to disclose a “contact nose,” as recited by claim 17.

Rejections to the Claims Under 35 U.S.C. § 103(a)

Claims 1 and 3-20 are rejected under 35 U.S.C. § 103(a) as obvious over AAPA in view of U.S. Patent No. 1,241,996 to Kristiansen (“Kristiansen”). Claims 1 and 3-16 are rejected under 35 U.S.C. § 103(a) as obvious over JP-A-2002-337066 in view of Kristiansen for the reasons as set forth in paragraph 11 of the Office Action dated March 26, 2007. Applicants respectfully disagree.

Claims 1 and 8

As stated above JP-A-2002-337066 fails to disclose or suggest a “contact nose,” as recited by claim 1 or claim 8. Although Kristiansen discloses a tool for nailing parquet floors, it does not disclose or suggest a “contact nose” as recited by claim 1 or 8. Thus, Kristiansen fails to remedy the deficiency of JP-A-2002-337066. Accordingly, the rejection of claims 1 and 8 under 35 U.S.C §103 should be withdrawn.

Claims 3-7 and 9-20

Claims 3-7 and 9-20 depend or ultimately depend from claim 1 or 8, and thus are believed patentable over JP-A-2002-337066 and Kristiansen for the same reasons as claim 1 or claim 8 as well as the additional features they recite.

New claim 21

New claim 21 recites additional features of the power-driven nailing machine of claim 8, and thus is believed patentable over JP-A-2002-337066 and Kristiansen for the same reasons as claim 8 as well as the additional features it recites.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance, and thus request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: 

Arthur M. Antonelli
Reg. No. 51,410

Dated: March 23, 2009

Customer No.: 009629

MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: 202-739-3000
Facsimile: 202-739-3001